

The opinion in support of the decision being entered today was
not written for publication and is not binding precedent of the
Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

FEB 11 2002

PAT. & TM. OFFICE
BOARD OF PATENT APPEALS
U.S. DEPARTMENT OF COMMERCE

Ex parte ICHIRO FUJIEDA
and
TAKESHI SAITO

Appeal No. 2001-0390
Application 08/932,238

ORDER REMANDING TO EXAMINER

Effective April 21, 1995, 37 CFR § 1.192(c)¹ was amended to provide as follows (underlining added for emphasis):

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

(1) Real party in interest. A statement identifying the real party in

¹ 60 F.R. 14518 (March 17, 1995), 1173 O.G. 62 (April 11, 1995).

interest, if the party named in the caption of the brief is not the real party in interest.

(2) Related appeals and interferences. A statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

The brief filed July 12, 2000 (Paper No. 20) is defective under 37 CFR § 1.192(d) because it fails to comply with the provisions of the rule pertaining to both the "real party in interest" and "related appeals and interferences."

The Manual of Patent Examining Procedure (MPEP) § 1206 (7th Ed., Rev. 1, Feb. 2000) states:

If appellant does not name a real party in interest, the examiner will assume that the party named in the caption of the brief is the real party in interest, i.e., the owner at the time the brief is being filed.

. . . While the examiner will assume that the real party in interest is the individual or individuals identified in the caption when the real party in interest is not explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly name the real party in interest. See MPEP § 1210.01.

MPEP § 1206 further states:

. . . If appellant does not identify any other appeals or interferences, the

examiner will presume that there are none. While the examiner will assume that there are no related cases when no related case is explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly identify any related case. See MPEP § 1210.01.

The examiner may presume that the real party in interest is the party named in the caption of the brief and that there are no related appeals and interferences, if appellants present the headings but fail to provide the corresponding statements under the headings. Nevertheless, the examiner is encouraged to request from appellants not only the required headings but also explicit statements naming the real party in interest and identifying any related appeals and interferences in order to avoid further delays in the appeal process, since the Board will otherwise require appellants to explicitly identify the real party in interest and any related appeals and interferences.

In addition, an Information Disclosure Statement (IDS) was filed September 17, 1997 (Paper No. 5). It is not apparent from the record whether the examiner considered the statement submitted or notified appellants of why their submission did not meet the criteria set forth in 37 CFR § 1.97 and 1.98. A

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communication notifying appellants of the Primary Examiner's decision is required.

Finally, an amendment after final was filed by appellants on March 8, 2000 (Paper No. 16). The Advisory Action mailed March 23, 2000 (Paper No. 17) indicated that such amendment would be entered upon filing an appeal. The Examiner's Answer mailed September 14, 2000 (Paper No. 21) also indicated that this amendment had been entered. A review of the record reveals that the amendment was not entered. It should be noted that the March 8, 2000 amendment (Paper No. 16) appears to be a duplicate of the amendment filed November 24, 1999 (Paper No. 13) which was entered pursuant to the Advisory Action mailed February 9, 1999 (Paper No. 14). Clarification is required regarding the entry status of the amendment filed March 8, 2000 (Paper No. 16).

Accordingly, it is

ORDERED that the application is remanded to the examiner:

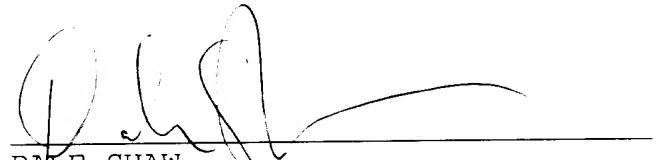
1. for resolution of the issues set forth above regarding both the "real party in interest" and "related appeals and interferences";

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2. for consideration of the IDS mailed September 17, 1997 (Paper No. 5) and appropriate notification to appellants regarding the Primary Examiner's decision;
3. for clarification regarding the entry status of the amendment filed March 8, 2000 (Paper No. 16); and
4. for such further action as may be deemed appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES



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